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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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KIMBERLY-CLARK WORLDWIDE, INC.
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EXAMINER

REICHLE, KARIN M

ART UNIT PAPER NUMBER

3761

DATE MAILED: 11/28/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,326

Applicant(s)

DAVIS ET AL.

Examiner

Karin M. Reichle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,8-12,15,17,32 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,2,5-7,13,14,16,18-31 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner. ^{in part}
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9-8-03 has been entered.

Election/Restrictions

2. Claims 3, 4, 8-12, 15, 17, 32, and 34, are still withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

Specification

3. The substitute specification filed 9-8-03 was not entered because, e.g., the abstract as proposed did not comply with 37 CFR 1.121, i.e. all the changes made thereto were not shown, and the abstract was now too short, i.e. less than 50 words in length. Additionally, there does not appear to be support as originally filed for the invention as now described and/or the invention is inconsistently described. For example, on page 3 of the marked up copy of the specification Figures 4 and 5 are originally described as showing the same embodiment from the outside and

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the inside. Referring to to pages 11-12 of the marked up copy, that embodiment as originally described included an external bellows. An alternative embodiment using a mechanically assisted pump means was disclosed starting at page 12, line 3 of the marked up copy. However, such pump means was not disclosed as being internal nor was such pump means disclosed in combination with the bellows, i.e. a manually assisted pumping means. Therefore the proposed Figures and substitute specification describe an embodiment which is at least inconsistent with the description of the embodiment of Figures 4-5 as originally described and at most are not supported by the originally filed specification.

Drawings

4. The drawings were received on 9-8-03. These drawings are approved in part by the Examiner. Figures 3 and 4 only as proposed are approved. With regard to proposed Figure 5, see discussion in paragraph 3 *supra*.

5. The drawings are objected to because in Figure 5, 32 does not appear to denote a connection means. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the invention as claimed in claims 1-2, 5-7, 13-14, 16, 18-31 and 33, i.e. means for connecting which permits the connection of a pumping means, i.e. the bellows, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

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A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Description

7. The abstract of the disclosure is objected to because legal terminology, i.e. "means", should be avoided. Correction is required. See MPEP § 608.01(b).

8. The disclosure is objected to because of the following informalities: 1) The Summary of the Invention section, i.e. a description of the claimed invention, and the invention of the claims should be commensurate, see MPEP 608.01(d) and 1302.01, e.g. where in the claims is desiccant on the inside of the valving means claimed? 2) On page 5, line 12, since STARRET is a trademark, the word "-type" should be avoided, i.e. the tester either originates from the source designated by the trademark or not. 3) In the paragraph bridging pages 12-13, the terminology, i.e. "In the claims...structures." should be avoided, i.e. such describes legal interpretation which is determined by the courts and the legislature. The paragraph set forth in the 3-17-03 response was not entered because it did not comply with 37 CFR 1.121, i.e. the marked up copy and the clean copy do not agree.

Appropriate correction is required.

Claim Objections

9. Claims 6-7, 13, 16, 18-19 and 30-31 are objected to because of the following informalities: in claim 6, "passing" on line 3 should be --passage of--. In claim 13, line 2,

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before “valve”, --second-- should be inserted. In claim 30, “actuated ... for pumping” should be --manually or mechanically actuated-- to be accurate. Appropriate correction is required.

Claim Language Interpretation

10. “Personal care product” as claimed in claim 20 and the preambles of claims 28-29, 30-31 and 33 is defined as set forth on page 5, first full paragraph from the bottom. The use of the “means for” phrase in combination with functional language, i.e. means for valving in claims 1-2, 5, and 13, and thereby claims dependent therefrom, means for pumping in claims 6-7, 16, 18 and 19 and thereby the claims dependent therefrom, and means for distributing in claims 28-29, and thereby the claims which depend therefrom, does not invoke 35 USC 112, sixth paragraph, since such phrase and language is modified by sufficient structure, material or acts for achieving the specified function, e.g. a one way valve, piping or tubing, means for manually or mechanically assisting, external bellows, two one way valves. The phrase and language, i.e. means for connecting which permits the connecting of a means for pumping in claims 1, 5, 6, and 14, and thereby the claims which depend therefrom, and means for manually or mechanically assisting in claims 6, 14, 16, 18 and 19 does invoke 35 USC 112, sixth paragraph because it is not modified by specific structure, materials or acts for achieving the specified structure. The means for connecting are considered to be as defined in the paragraph bridging pages 7-8, page 9, lines 11-12 and 29-31, page 11, lines 6-7 and 12-13, page 11, first full paragraph and paragraph bridging pages 12-13 and Figure 5, i.e. any structure which permits discharge from pumping means to pass into article or product. The means for manually or mechanically assisting passage of air are defined on page 8, first full paragraph, page 9, line 27-

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page 11, line 6, page 11, line 15- page 13, line 2 and Figures 4-5, e.g. a bellows. It is noted that the functional, capability or property language of claim 30, i.e. "adapted ... pumping", is interpreted as --adapted to be manually or mechanically actuated-- as set forth in the portions cited with regard to the means for manually or mechanically assisting supra.

Claim Rejections - 35 USC § 102

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 1-2, 5-7, 13-14, 16, 18-31 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Lau et al '749

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

See Figures 4 and 5 of Lau, i.e. absorbent article or personal care product having a topsheet and backsheet 20, see also col. 3, lines 44-50, valving means or distribution means, e.g. 25 is valve, connection leading thereto is piping, juncture between piping and 21 is connection means, pumping means, i.e. bellows 21, valves 24. Also see abstract, col. 1, lines 56-67, col. 2, lines 10-13, col. 3, lines 18-20, col. 4, lines 4-60, col. 5, lines 7-14, 25-38 and 47-52, col. 6, lines 20-50 and claims. Attention is also directed to Figures 4 and 5 of the instant application.

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Therefore the Lau reference teaches elements which perform identical function in substantially the same way and produces substantially the same results and/or is the structural equivalent of that set forth in the claims.

Claim Rejections - 35 USC § 103

13. Claims 1-2, 5-6, 14, 16, 20-31 and 33 are directed to an invention not patentably distinct from claims 5-6 of commonly assigned 6,454,749. Specifically, Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of both the application and patent require a "personal care product" as interpreted in light of the descriptions, see portions of patent cited supra, the patent claims require distribution means including piping conveying air from a bellows, i.e. obviously the bellows is a self contained manual assisted pump and there is a structure between the piping and bellows to provide the conveying which is a "connection" therebetween and both the claims of the application and patent require distribution of air or air exchange between the wearer's skin and the product(In other words, the application claims are merely broader, i.e. generic to, than the patent claims. Once the applicant has received a patent for a species or a more specific embodiment he is not entitled to a patent for the generic or broader invention. This is because the specific anticipates the broader. The patented claims anticipate the application claims. See In re Goodman, supra.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302).

Commonly assigned 6,454,749, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under

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35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 35 U.S.C. 103(c) and 37 CFR 1.78(c) to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Response to Arguments

14. Applicants remarks on pages 6-9 with regard to matters of form have been considered but are either deemed moot in that such matters have not been reraised or deemed nonpersuasive for the reasons set forth supra. Applicants remarks on page 9 with regard to the terminal disclaimer have been noted but while such is sufficient to overcome the double patenting rejection such a terminal disclaimer can not be used to overcome the rejections set forth in paragraphs 12-13 supra.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows various ventilation systems for removing moisture from the skin.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (703) 308-2617.

The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (703) 308-1957. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.


Karin M. Reichle
Primary Examiner
Art Unit 3761

KMR
November 25, 2003